



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
GROUP ART UNIT 3724

I, Deborah Newton, hereby certify that this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on the date of my signature.

Deborah Newton
Signature

2-11-03
Date of Signature

Patent Application of

Thomas Richard Bednar, et al.

Serial No. 09/892,096

Filed: June 26, 2001

Examiner: Omar Flores Sanchez

"RECIPROCATING SAW"

APPEAL BRIEF

RECEIVED

FEB 20 2003

Commissioner of Patents
and Trademarks
Washington, DC 20231

TECHNOLOGY CENTER R3700

Sir:

Applicants have appealed from the decision dated September 11, 2002 of the Examiner finally rejecting Claims 2-3, 5-12 and 23-30 and objecting to Claims 13-14. This Appeal Brief is submitted in triplicate in support thereof. A check for \$320.00 in payment of the fee for this Appeal Brief is submitted herewith. Charge or credit Deposit Account No. 13-3080 with any shortage or overpayment of the fees associated with this communication.

Applicants' attorney timely filed a Notice of Appeal on December 11, 2001. Applicants' attorney also submitted with the Notice of Appeal, an Amendment after Final Office Action under 37 C.F.R. §1.116 to place Claims 13-14 in condition for allowance and to place the application in a better condition for consideration on appeal. As discussed below in more detail, the Examiner entered the Amendment after Final Office Action and allowed Claims 13-14. In the Appendix of the present Appeal Brief, allowed Claims 13-14 are presented as amended in the Amendment after Final Office Action.

REAL PARTY IN INTEREST

The real party in interest is Milwaukee Electric Tool Corporation, 13135 West Lisbon Road, Brookfield, Wisconsin 53005.

02/18/2003 MBERHE 00000016 09892096

01 FC:1402

320.00 OP

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 2-3, 5-14 and 23-30 are pending. Claims 2-3, 5-12 and 23-30 stand finally rejected and appealed, and Claims 13-14 have been allowed.

STATUS OF AMENDMENTS

On December 11, 2002, Applicants submitted an Amendment after Final Office Action including amendments to Claims 13-14 to place these claims in condition for allowance and to place the application in a better condition for consideration on appeal. In an Advisory Action faxed to Applicants' attorney on February 6, 2003, the Examiner entered the Amendment after Final Office Action and allowed Claims 13-14. Applicants appreciate the Examiner's allowance of Claims 13-14.

SUMMARY OF THE INVENTION

A reciprocating saw 10 embodying the present invention is illustrated in Fig. 1. The reciprocating saw 10 generally includes a main housing 14 having an operator's handle 18, a forward portion 22 opposite the handle portion 18, and an upper portion 26. Page 8, lines 31-34.

An electric motor 30 is supported by the housing 14. The motor 30 includes a drive pinion 34 that engages a gear 38 mounted on a drive shaft 42. The drive shaft 42 is rotatably mounted within the housing 14. Page 9, lines 1- 3. A switch 46 is located in the operator's handle 18 for energizing the motor 30 to rotate the drive shaft 42. Page 9, lines 5-6.

A spindle 50 (partially shown) is supported by the housing for reciprocating and pivoting movement (e.g., orbital movement) relative to the housing 14. As shown in Fig. 2, the spindle 50 includes a front end 54 that supports a saw blade 58, which is designed to cut in a cutting direction 62 (i.e., in the direction of the saw teeth) opposite a non-cutting direction 66. The spindle 50 generally reciprocates the saw blade 58 through a cutting stroke (usually toward the housing 14) and a return stroke (usually away from the housing 14). Page 9, lines 7-13.

The reciprocating saw 10 also includes (see Fig. 2) a reciprocating drive assembly for driving the spindle 50 and the counterweight 70. In the illustrated construction, the

reciprocating drive assembly includes a wobble plate drive assembly drivingly engaging the spindle 50 for reciprocating movement. Page 9, lines 19-29.

The reciprocating saw 10 also includes (see Figs. 1, 2, 8, and 9) an adjustable shoe assembly including (see Figs. 1-2) a shoe plate 194 having a surface for engaging a surface of a workpiece W. The shoe plate 194 defines an aperture 198 through which the saw blade 58 is extendable. The aperture 198 is dimensioned to accommodate the orbital path of the saw blade 58. Page 14, lines 23-27.

The adjustable shoe assembly also includes (see Figs. 1, 2, 8, and 9) a shoe support member 202 pivotally connected to the shoe plate 194. The shoe support member 202 is movably supported by the housing 14 to adjust the position of the shoe plate 194 relative to the housing 14. Page 14, lines 28-31.

A shoe retaining plate 206 is supported in a slot 210 (see Fig. 2) defined in the housing 14 to form a channel in which the shoe support member 202 is movable. Page 14, lines 32-34. The shoe support member 202 includes (see Figs. 2, 8, and 9) a plurality of pairs of teeth 214 spaced along the length of the shoe support member 202. One tooth 214 of each pair is formed on each lateral side of the shoe support member 202. Page 15, lines 5-8.

As shown in Figs. 1, 2 and 9, a rubber boot 216 covers and seals the forward portion of the housing 14 and the shoe retaining plate 206. The boot 216 also provides an improved gripping surface for the operator. Page 15, lines 9-11.

The adjustable shoe assembly also includes a locking member 218 pivotally supported by the housing 14. The locking member 218 is generally cylindrical but includes an axially-extending flat surface 222. A shoe release lever 226 is pivotally supported on the lower, forward portion 22 of the housing 14 and is connected to the locking member 218 so that pivotal movement of the lever 226 causes pivotal movement of the locking member 218. In this location, an operator can engage the lever 226 from either side of the housing 14 with either hand. A metal insert 228 is co-molded with the lever 226 to provide additional strength to the lever 226. Page 15, lines 12-20.

The lever 226 is movable between a first or locked position (shown in Fig. 2) and a second or released position (shown in Fig. 9). In the locked position (Fig. 2), the locking member 218 is pivoted so that the locking member 218 engages the teeth 214. The rounded portion of the locking member 218 engages the forward rounded surface of each of a pair of teeth 214, and the flat surface 222 engages the adjacent pair of teeth 214. In this manner, the shoe support member 202 is substantially prevented from moving relative to the housing 14. Page 15, lines 21-27.

To adjust the position of the shoe plate 194 relative to the housing 14, the operator moves the lever 226 to the release position (Fig. 9). As the lever 226 is pivoted to the release position, the locking member 218 is pivoted relative to the shoe support member 202. In the release position (Fig. 9), the locking member 218 is pivoted so that the locking member 218 does not engage the teeth 214. The teeth 214 are movable beneath the flat surface 222 of the locking member 218. With the lever 226 maintained in the release position, the operator can adjust the shoe plate 194 relative to the housing 14 so that the shoe plate 194 is in an optimum position for cutting. Page 15, line 28-page 16, line 2.

Once the shoe plate 194 is in the desired position, the lever 226 is pivoted to the locked position (Fig. 2), and the operator performs the cutting operation with the reciprocating saw 10. During cutting operations, the lever 226 is normally grasped by the operator in the locked position so that the locking member 218 will be maintained in this locked position. Page 16, lines 3-7.

The adjustable shoe assembly also includes a biasing member (not shown) to normally bias the lever 226 toward the locked position. The spring is preferably supported so that, as the lever 226 is moved to the release position, the spring moves over-center to bias the lever 226 toward the release position. Page 16, lines 8-11.

STATEMENT OF THE ISSUES

1. Whether Claims 2-3, 5-7, 10-12, 23-24 and 27 are unpatentable under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,007,172 ("Palm").

2. Whether Claims 8-9, 25-26 and 28-30 are unpatentable under 35 U.S.C. §103(a) as being obvious over Palm.

GROUPING OF THE CLAIMS

The rejected claims do not stand or fall together, and the following groups are separately patentable:

- Group I: Claims 2-3 and 5-7;
- Group II: Claim 8;
- Group III: Claim 9;
- Group IV: Claims 10-12;
- Group V: Claims 23-24;
- Group VI: Claim 25;

Group VII: Claim 26;
Group VIII: Claim 27;
Group IX: Claim 28;
Group X: Claim 29; and
Group XI: Claim 30.

THE REFERENCE

U.S. Patent No. 5,007,172 ("Palm")

Palm discloses a reciprocating saw including a gear case 22 supporting a reciprocating spindle 26. The gear case 22 is provided with a hole 28, which receives a post 30 of a shoe 32. The rear portion of the post 30 includes grooves 36, 38, 40 separated by lands 42, 44 which lie in a plane which is below the plane of the flat 46 provided on a pin 48. The pin 48 is rotatably mounted in the gear case 22 transverse the axis of the post 30 so that, when the pin 48 is rotated to position the flat 46 parallel to the lands 42, 44, the post 30 can be moved freely in the hole 28 to adjust the position of the shoe 32 relative the saw blade. To rotate the pin 48, the user actuates the lever 52 mounted on the outer end of the pin 48. When the shoe 32 is in the desired position, the pin 48 is rotated to move the round portion 50 of the pin into registry with one of the grooves 36, 38, 40 in the post 30 to lock the post 30 and shoe 32.

Palm does not teach or suggest a reciprocating saw comprising, among other things, a locking member including a first end and a second end, the reciprocating saw further comprising a locking assembly operable to lock the shoe support in a position relative to the housing, the housing assembly including a lever engaging the first end and the second end of the locking member. Rather, in Palm, the lever 52 engages only the outer end 54 of the pin 48. As shown in Fig. 4 of Palm, the lever 52 does not engage the opposite end of the pin 48.

Additionally, Palm does not teach or suggest a reciprocating saw comprising, among other things, a retainer member supported by the housing and defining a channel, the shoe support member being movable in the channel. Rather, Palm discloses that the gear case 22 is provided with a hole 28 which receives the post 30 of the shoe 32. Palm does not teach or suggest any structure corresponding to a retainer member supported by the housing.

Also, Palm also does not teach or suggest a reciprocating saw including a first lever member formed of a moldable material and a second lever member formed of a metallic material, the second lever member being molded with the first lever member, the second lever member defining a recess, one of the first end and the second end of the locking

member engaging the recess. In Palm, there is no teaching or suggestion that the lever 52 includes a moldable first lever member and a metallic second lever member.

In addition, Palm does not teach or suggest that the second lever member defines a first recess and a second recess, the first end and the second end of the locking member respectively engaging the first recess and the second recess. Rather, in Palm, the lever 52 includes a single opening, and the pin 48 extends through the one opening in the lever 52.

THE REJECTIONS

First, the Examiner rejected Claims 2-3, 5-7, 10-12, 23-24 and 27 under 35 U.S.C. §102(b) as being anticipated by Palm. The Examiner states that “Palm discloses the invention including a lever 52, a locking member 48, 56, a first end (the head of screw 56), a second end 54, a plurality of teeth (Fig. 5), a retainer member (the inside wall of the hole 28) supported by the housing and defining a channel 28.” See Office action, dated September 11, 2002, section 2.

Second, the Examiner rejected Claims 8-9, 25-26 and 28-30 under 35 U.S.C. §103(a) as being unpatentable over Palm. The Examiner states that Palm discloses a reciprocating saw substantially as claimed except that Palm’s reciprocating saw does not include a first recess, a second recess, and a second lever formed of a metallic material. However, the Examiner “takes Official Notice that the use of a first recess, a second recess, and a second lever formed of a metallic material are old and well known in the art for the purpose of increasing the stiffness in the lever.” The Examiner further states that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Palm’s lever by producing the first recess, the second recess, and the second lever formed of a metallic material in order to obtain an increase of stiffness in the lever.” See Office action, dated September 11, 2002, section 4.

Third, the Examiner indicated that Claims 13-14 include allowable subject matter and objected to Claims 13-14 as being dependent upon a rejected base claim. On December 11, 2002, Applicants submitted an Amendment after Final Office Action including amendments to Claims 13-14 to place these claims in condition for allowance and to place the application in a better condition for consideration on appeal. In the Advisory Action faxed to Applicants’ attorney on February 6, 2003, the Examiner allowed amended Claims 13-14.

ARGUMENT

Claim rejections under 35 U.S.C. §102(b)

To prove a *prima facie* case of anticipation, the Examiner must show that each and every element as set forth in the claim is either expressly or inherently described in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Group I

The claims of Group I, Claims 2-3 and 5-7, are patentable separately from the claims of the other groups, as described below in more detail.

Independent Claim 7 defines a reciprocating saw comprising a housing including a first grip surface for an operator's first hand and a second grip surface for an operator's second hand, a motor supported by the housing, a spindle movably supported by the housing, the spindle having an end adapted to support a saw blade, a drive mechanism connected between the motor and the spindle to reciprocally drive the spindle relative to the housing upon operation of the motor, a shoe for engaging a surface of a workpiece, a shoe support member supporting the shoe, the shoe support member being movably supported by the housing, a locking assembly operable to lock the shoe support member in a position relative to the housing, and a lever for operating the locking assembly between a locked condition, in which the shoe support member is locked in a position relative to the housing, and an unlocked condition, in which the shoe support member is movable relative to the housing. The lever is supported on the first grip surface such that, during operation of the saw, the operator's first hand engages the first grip surface and the lever and thereby maintains the lever in a locked position corresponding to the locked condition of the locking assembly. The locking assembly includes a locking member engageable with the shoe support member. The lever is operable to move the locking member between a locked position, in which the locking member engages the shoe support member to lock the shoe support member in a position relative to the housing, and an unlocked position, in which the shoe support member is moveable relative to the housing. The locking member has a first end and a second end, and the lever engages the first end and the second end of the locking member.

Palm does not teach or suggest the claimed reciprocating saw. Palm does not teach or suggest a reciprocating saw comprising, among other things, a locking assembly operable to

lock the shoe support member in a position relative to the housing, the locking assembly including a locking member having a first end and a second end, the reciprocating saw further comprising a lever engaging the first end and the second end of the locking member. Rather, in Palm, the lever 52 engages only the outer end 54 of the pin 48. As shown in Fig. 4 of Palm, the lever 52 does not engage the opposite end of the pin 48. There is no teaching or suggestion in Palm that the lever 52 should or could engage the opposite end of the pin 48.

Palm does not teach or suggest each and every element of independent Claim 7.

Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of anticipation of Claim 7 based upon the prior art as required by 35 U.S.C. §102.

For these and other reasons, Palm does not teach or suggest the subject matter defined by independent Claim 7. Accordingly, independent Claim 7 is allowable. Dependent Claims 2-3, 5-6 and 8-9 depend from Claim 7 and are allowable for the same and other reasons. In addition, the additional subject matter defined by the dependent claims provides separate bases for allowance.

Group IV

The claims of Group IV, Claims 10-12, are patentable separately from the other claims because these claims do not include all the limitations of the other claims and because these claims specify a retainer member supported by the housing and defining a channel, the shoe support member being movable in the channel. More specifically, even if the other claims are found to be anticipated by or obvious in view of Palm, Claims 10-12 are still patentable because there is no teaching, suggestion or incentive to provide the claimed reciprocating saw, as described below in more detail.

Independent Claim 10 defines a reciprocating saw comprising a housing including a first grip surface for an operator's first hand and a second grip surface for an operator's second hand, a motor supported by the housing, a spindle movably supported by the housing, the spindle having an end adapted to support a saw blade, a drive mechanism connected between the motor and the spindle to reciprocally drive the spindle relative to the housing upon operation of the motor, a shoe for engaging a surface of a workpiece, a shoe support member supporting the shoe, the shoe support member being movably supported by the housing, a locking assembly operable to lock the shoe support member in a position relative to the housing, and a lever for operating the locking assembly between a locked condition, in which the shoe support member is locked in a position relative to the housing, and an unlocked condition, in which the shoe support member is movable relative to the housing.

The lever is supported on the first grip surface such that, during operation of said saw, the operator's first hand engages the first grip surface and the lever and thereby maintains the lever in a locked position corresponding to the locked condition of the locking assembly. The reciprocating saw is defined as further comprising a retainer member supported by the housing and defining a channel, the shoe support member being movable in the channel.

Palm does not teach or suggest a reciprocating saw comprising, among other things, a retainer member supported by the housing and defining a channel, the shoe support member being movable in the channel. Rather, Palm discloses that the gear case 22 is provided with a hole 28 which receives the post 30 of the shoe 32. Palm does not teach or suggest any structure corresponding to a retainer member supported by the housing. Further, in Palm, there is no teaching or suggestion that the reciprocating saw should or could include such a retainer member.

Palm does not teach or suggest each and every element of independent Claim 10. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of anticipation of Claim 10 based upon the prior art as required by 35 U.S.C. §102.

For these and other reasons, Palm does not teach or suggest the subject matter defined by independent Claim 10. Accordingly, independent Claim 10 is allowable. Dependent Claims 11-12 depend from Claim 10 and are allowable for the same and other reasons. In addition, the additional subject matter defined by the dependent claims provides separate bases for allowance.

Group V

The claims of Group V, Claims 23-24, are patentable separately from the other claims because these claims do not include all the limitations of the other claims and because these claims specify a locking member including a first end and a second end, and a lever engaging the first end and the second end of the locking member. More specifically, even if the other claims are found to be anticipated by or obvious in view of Palm, Claims 23-24 are still patentable because there is no teaching, suggestion or incentive to provide the claimed reciprocating saw, as described below in more detail.

Independent Claim 23 defines a reciprocating saw comprising a housing, a motor supported by the housing, a spindle movably supported by the housing, the spindle having an end adapted to support a saw blade, a drive mechanism connected between the motor and the spindle to reciprocally drive the spindle relative to the housing upon operation of the motor, a shoe for engaging a surface of a workpiece, a shoe support member supporting the shoe, the

shoe support member being movably supported by the housing, a locking assembly operable to lock the shoe support member in a position relative to the housing, the locking assembly including a locking member engageable with the shoe support member, the locking member having a first end and a second end, and a lever operable to move the locking member between a locked position, in which the locking member engages the shoe support member to lock the shoe support member in a position relative to the housing, and an unlocked condition, in which the shoe support member is movable relative to the housing. The lever engages the first end and the second end of the locking member.

Palm does not teach or suggest a reciprocating saw comprising, among other things, a locking member including a first end and a second end, and a lever engaging the first end and the second end of the locking member. Rather, in Palm, the lever 52 engages only the outer end 54 of the pin 48. As shown in Fig. 4 of Palm, the lever 52 does not engage the opposite end of the pin 48. There is no teaching or suggestion in Palm that the lever 52 should or could engage the opposite end of the pin 48.

Palm does not teach or suggest each and every element of independent Claim 23. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of anticipation of Claim 10 based upon the prior art as required by 35 U.S.C. §102.

For these and other reasons, Palm does not teach or suggest the subject matter defined by independent Claim 23. Accordingly, independent Claim 23 is allowable. Dependent Claims 24-27 depend from Claim 23 and are allowable for the same and other reasons. In addition, the additional subject matter defined by the dependent claims provides separate bases for allowance.

Group VIII

The claim of Group VIII, Claim 27, is patentable separately from the other claims because Claim 27 does not include all the limitations of the other claims and because Claim 27 specifies that the reciprocating saw includes a retainer member supported by the housing and defining a channel, the shoe support member being movable in the channel, and that the retainer member defines a first opening and a second opening respectively receiving the first end and the second end of the locking member. More specifically, even if the other claims are found to be anticipated by or obvious in view of Palm, Claim 27 is still patentable because there is no teaching, suggestion or incentive to provide the claimed reciprocating saw, as described below in more detail.

Claim 27 depends from Claim 23 and specifies that the reciprocating saw further includes a retainer member supported by the housing and defining a channel, the shoe support member being movable in the channel and that the retainer member defines a first opening and a second opening respectively receiving the first end and the second end of the locking member.

The arguments presented above regarding the failure of Palm to teach or suggest the limitations of Claim 23 apply with equal weight to Claim 27. Rather than re-present the arguments set forth above, Applicants refer to the discussion above for Claim 27.

In addition to the arguments set forth above, Palm does not teach or suggest any structure corresponding to a retainer member. Rather, Palm discloses that the gear case 22 is provided with a hole 28 which receives the post 30 of the shoe 32. There is no teaching or suggestion in Palm that the reciprocating saw should or could include such a retainer member. Also, in Palm, the pin 48 extends through a hole in the gear case 22, and the ends of the pin 48 are not received in such a retainer member.

Palm does not teach or suggest each and every element of Claim 27. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of anticipation of Claim 27 based upon the prior art as required by 35 U.S.C. §102.

For these and other reasons, Palm does not teach or suggest the subject matter defined by independent Claim 23 or by dependent Claim 27. Accordingly, Claim 27 is allowable.

Claim rejections under 35 U.S.C. §103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 U.S.P.Q. 871, 881 (CCPA 1981). In proceedings before the Patent and Trademark Office, the Examiner bears the burden of presenting a *prima facie* case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In re Vaeck, 947 F.2d 488, 493, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. Id. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim

limitations. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (CCPA 1974); MPEP §§706.02(j), 2143.03.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Appellant's disclosure. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); In re Vaeck, 947 F.2d at 493, 20 U.S.P.Q.2d at 1442; MPEP §2143. The Examiner can only establish a *prima facie* case of obviousness by pointing out some objective teaching in the prior art references themselves that would lead one of ordinary skill in the art to combine the relevant teachings and the references. In re Fine, 837 F.2d at 1074, 5 U.S.P.Q.2d at 1598-99; In re Jones, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992); MPEP §2143.01.

In addition, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984); In re Mills, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); MPEP §2143.01.

Group II

The claim of Group II, Claim 8, is patentable separately from the other claims because Claim 8 does not include all the limitations of the other claims and because Claim 8 specifies that the lever includes a first lever member formed of a moldable material and a second lever member formed of a metallic material, the second lever member being molded with the first lever member, the second lever member defining a recess, one of the first end and the second end of the locking member engaging the recess. More specifically, even if the other claims are found to be anticipated by or obvious in view of Palm, Claim 8 is still patentable because there is no teaching, suggestion, or incentive to provide the claimed reciprocating saw, as described below in more detail.

Claim 8 depends from Claim 7 and specifies that the lever includes a first lever member formed of a moldable material and a second lever member formed of a metallic material, the second lever member being molded with the first lever member, the second

lever member defining a recess, one of the first end and the second end of the locking member engaging the recess.

The arguments presented above regarding the failure of Palm to teach or suggest the limitations of Claim 7 apply with equal weight to Claim 8. Rather than re-present the arguments set forth above, Applicants refer to the discussion above for Claim 7.

In addition to the arguments set forth above, Palm does not teach or suggest a reciprocating saw including a lever including a first lever member formed of a moldable material and a second lever member formed of a metallic material, the second lever member being molded with the first lever member, the second lever member defining a recess, one of the first end and the second end of the locking member engaging the recess. In Palm, there is no teaching or suggestion that the lever 52 includes a moldable first lever member and a metallic second lever member. Further, in Palm, there is no teaching or suggestion that the lever 52 should or could include a moldable first lever member and a metallic second lever member.

Palm does not teach or suggest all of the claim limitations of Claim 8. Palm also does not teach or suggest that the lever 52 should or could be modified as suggested by the Examiner. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 8 based upon the prior art as required by 35 U.S.C. §103.

For these and other reasons, Palm does not teach or suggest the subject matter defined by dependent Claim 8. Accordingly, dependent Claim 8 is allowable. Dependent Claim 9 depends from Claim 8 and is allowable for the same and other reasons. In addition, the subject matter defined by dependent Claim 9 provides separate bases for allowance.

Group III

The claim of Group III, Claim 9, is patentable separately from the other claims because Claim 9 does not include all the limitations of the other claims and because Claim 9 specifies that the second lever member defines a first recess and a second recess, the first end and the second end of the locking member respectively engaging the first recess and the second recess. More specifically, even if the other claims are found to be anticipated by or obvious in view of Palm, Claim 9 is still patentable because there is no teaching, suggestion or incentive to provide the claimed reciprocating saw, as described below in more detail.

Claim 9 depends from independent Claim 7 and from dependent Claim 8 and specifies that the second lever member defines a first recess and a second recess, the first end

and the second end of the locking member respectively engaging the first recess and the second recess.

The arguments presented above regarding the failure of Palm to teach or suggest the limitations of independent Claim 7 apply with equal weight to Claim 9. Also, the arguments presented above regarding the failure of Palm to teach or suggest the limitations of Claim 8 apply with equal weight to Claim 9. Rather than re-present the arguments set forth above, Applicants refer to the discussion above for Claim 7 and Claim 8.

In addition to the arguments set forth above, Palm does not teach or suggest that the second lever member defines a first recess and a second recess, the first end and the second end of the locking member respectively engaging the first recess and the second recess. Rather, in Palm, the lever 52 includes a single opening, and the pin 48 extends through the one opening in the lever 52. There is no teaching or suggestion in Palm that the lever 52 should or could engage the opposite end of the pin 48.

Palm does not teach or suggest all of the claim limitations of Claim 9. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 9 based upon the prior art as required by 35 U.S.C. §103.

For these and other reasons, Palm does not teach or suggest the subject matter defined by independent Claim 7, by dependent Claim 8 or by dependent Claim 9. Accordingly, dependent Claim 9 is allowable.

Group VI

The claim of Group VI, Claim 25, is patentable separately from the other claims because Claim 25 does not include all the limitations of the other claims and because Claim 25 specifies that the lever includes a first lever member formed of a moldable material and a second lever member formed of a metallic material, the second lever member being molded with the first lever member, the second lever member defining a recess, one of the first end and the second end of the locking member engaging the recess. More specifically, even if the other claims are found to be anticipated by or obvious in view of Palm, Claim 25 is still patentable because there is no teaching, suggestion or incentive to provide the claimed reciprocating saw, as described below in more detail.

Claim 25 depends from Claim 23 and specifies that the lever includes a first lever member formed of a moldable material and a second lever member formed of a metallic material, the second lever member being molded with the first lever member, the second

lever member defining a recess, one of the first end and the second end of the locking member engaging the recess.

The arguments presented above regarding the failure of Palm to teach or suggest the limitations of Claim 23 apply with equal weight to Claim 25. Rather than re-present the arguments set forth above, Applicants refer to the discussion above for Claim 23.

In addition to the arguments set forth above, Palm does not teach or suggest a reciprocating saw including a lever including a first lever member formed of a moldable material and a second lever member formed of a metallic material, the second lever member being molded with the first lever member, the second lever member defining a recess, one of the first end and the second end of the locking member engaging the recess. In Palm, there is no teaching or suggestion that the lever 52 includes a moldable first lever member and a metallic second lever member. Further, in Palm, there is no teaching or suggestion that the lever 52 should or could include a moldable first lever member and a metallic second lever member.

Palm does not teach or suggest all of the claim limitations of Claim 25. Palm also does not teach or suggest that the lever 52 should or could be modified as suggested by the Examiner. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 25 based upon the prior art as required by 35 U.S.C. §103.

For these and other reasons, Palm does not teach or suggest the subject matter defined by independent Claim 23 or by dependent Claim 25. Palm also does not teach or suggest that a lever should or could be modified as suggested by the Examiner. Accordingly, dependent Claim 25 is allowable. Dependent Claim 26 depends from Claim 25 and is allowable for the same and other reasons. In addition, the subject matter defined by dependent Claim 26 provides separate bases for allowance.

Group VII

The claim of Group VII, Claim 26, is patentable separately from the other claims because Claim 26 does not include all the limitations of the other claims and because Claim 26 specifies that the second lever member defines a first recess and a second recess, the first end and the second end of the locking member respectively engaging the first recess and the second recess. More specifically, even if the other claims are found to be anticipated by or obvious in view of Palm, Claim 26 is still patentable because there is no teaching, suggestion or incentive to provide the claimed reciprocating saw, as described below in more detail.

Claim 26 depends from independent Claim 23 and from dependent Claim 25 and specifies that the second lever member defines a first recess and a second recess, the first end and the second end of the locking member respectively engaging the first recess and the second recess.

The arguments presented above regarding the failure of Palm to teach or suggest the limitations of Claim 23 apply with equal weight to Claim 26. Also, the arguments presented above regarding the failure of Palm to teach or suggest the limitations of Claim 25 apply with equal weight to Claim 26. Rather than re-present the arguments set forth above, Applicants refer to the discussion above for Claim 23 and Claim 25.

In addition to the arguments set forth above, Palm does not teach or suggest that the second lever member defines a first recess and a second recess, the first end and the second end of the locking member respectively engaging the first recess and the second recess. Rather, in Palm, the lever 52 includes a single opening, and the pin 48 extends through the one opening in the lever 52. There is no teaching or suggestion in Palm that the lever 52 should or could engage the opposite end of the pin 48.

Palm does not teach or suggest all of the claim limitations of Claim 26. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 26 based upon the prior art as required by 35 U.S.C. §103.

For these and other reasons, Palm does not teach or suggest the subject matter defined by independent Claim 23, by dependent Claim 25 or by dependent Claim 26. Accordingly, dependent Claim 26 is allowable.

Group IX

The claim of Group IX, Claim 28, is patentable separately from the other claims because Claim 28 does not include all the limitations of the other claims and because Claim 28 specifies a lever including a first lever member formed of a moldable material and a second lever member formed of a metallic material. More specifically, even if the other claims are found to be anticipated by or obvious in view of Palm, Claim 28 is still patentable because there is no teaching, suggestion or incentive to provide the claimed reciprocating saw, as described below in more detail.

Independent Claim 28 defines a reciprocating saw comprising a housing, a motor supported by the housing, a spindle movably supported by the housing, the spindle having an end adapted to support a saw blade, a drive mechanism connected between the motor and the spindle to reciprocally drive the spindle relative to the housing upon operation of the motor, a

shoe for engaging a surface of a workpiece, a shoe support member supporting the shoe, the shoe support member being movably supported by the housing, a locking assembly operable to lock the shoe support member in a position relative to the housing, the locking assembly including a locking member engageable with the shoe support member, the locking member having a first end and a second end, and a lever operable to move the locking member between a locked position, in which the locking member engages the shoe support member to lock the shoe support member in a position relative to the housing, and an unlocked condition, in which the shoe support member is movable relative to the housing. The lever includes a first lever member formed of a moldable material and a second lever member formed of a metallic material. The second lever member is molded with the first lever member. The second lever member defines a recess. One of the first end and the second end of the locking member engages the recess.

Palm does not teach or suggest a reciprocating saw comprising, among other things, a lever including a first lever member formed of a moldable material and a second lever member formed of a metallic material. In Palm, there is no teaching or suggestion that the lever 52 includes a moldable first lever member and a metallic second lever member. Further, in Palm, there is no teaching or suggestion that the lever 52 should or could include a moldable first lever member and a metallic second lever member.

Palm does not teach or suggest all of the claim limitations of Claim 28. Palm also does not teach or suggest that the lever 52 should or could be modified as suggested by the Examiner. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 28 based upon the prior art as required by 35 U.S.C. §103.

For these and other reasons, Palm does not teach or suggest the subject matter defined by independent Claim 28. Accordingly, independent Claim 28 is allowable. Dependent Claims 29-30 depend from Claim 28 and are allowable for the same and other reasons. In addition, the subject matter defined by dependent Claims 29-30 provide separate bases for allowance.

Group X

The claim of Group X, Claim 29, is patentable separately from the other claims because Claim 29 does not include all the limitations of the other claims and because Claim 29 specifies a lever including a first lever member formed of a moldable material and a second lever member formed of a metallic material. More specifically, even if the other

claims are found to be anticipated by or obvious in view of Palm, Claim 29 is still patentable because there is no teaching, suggestion or incentive to provide the claimed reciprocating saw, as described below in more detail.

Dependent Claim 29 depends from independent Claim 28 and specifies that the second lever member defines a first recess and a second recess, the first end and the second end of the locking member respectively engaging the first recess and the second recess.

The arguments presented above regarding the failure of Palm to teach or suggest the limitations of Claim 28 apply with equal weight to Claim 29. Rather than re-present the arguments set forth above, Applicants refer to the discussion above for Claim 28.

In addition to the arguments set forth above, Palm also does not teach or suggest that the second lever member defines a first recess and a second recess, the first end and the second end of the locking member respectively engaging the first recess and the second recess. Rather, in Palm, the lever 52 includes a single opening, and the pin 48 extends through the one opening in the lever 52. There is no teaching or suggestion in Palm that the lever 52 should or could engage the opposite end of the pin 48.

Palm does not teach or suggest all of the claim limitations of Claim 29. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 29 based upon the prior art as required by 35 U.S.C. §103.

For these and other reasons, Palm does not teach or suggest the subject matter defined by independent Claim 28 or by dependent Claim 29. Accordingly, Claim 29 is allowable.

Group XI

The claim of Group XI, Claim 30, is patentable separately from the other claims because Claim 30 does not include all the limitations of the other claims and because Claim 30 specifies a retainer member supported by the housing and defining a channel, the shoe support member being moveable in the channel, and that the retainer member defines a first opening and a second opening respectively receiving the first end and the second end of the locking member. More specifically, even if the other claims are found to be anticipated by or obvious in view of Palm, Claim 30 is still patentable because there is no teaching, suggestion or incentive to provide the claimed reciprocating saw, as described below in more detail.

Dependent Claim 30 depends from independent Claim 28 and specifies that the reciprocating saw further comprises a retainer member supported by the housing and defining a channel, the shoe support member being movable in the channel and that the retainer

member defines a first opening and a second opening respectively receiving the first end and the second end of the locking member.

The arguments presented above regarding the failure of Palm to teach or suggest the limitations of Claim 28 apply with equal weight to Claim 30. Rather than re-present the arguments set forth above, Applicants refer to the discussion above for Claim 28.

In addition to the arguments set forth above, Palm does not teach or suggest any structure corresponding to a retainer member. Rather, Palm discloses that the gear case 22 is provided with a hole 28 which receives the post 30 of the shoe 32. Also, in Palm, there is no teaching or suggestion in that the reciprocating saw should or could include such a retainer member. Further, in Palm, the pin 48 extends through a hole in the gear case 22, and the ends of the pin 48 are not received in such a retainer member.

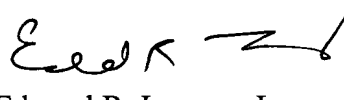
Palm does not teach or suggest all of the claim limitations of Claim 30. Palm also does not teach or suggest that the gear case 22 should or could be modified as suggested by the Examiner. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 30 based upon the prior art as required by 35 U.S.C. §103.

For these and other reasons, Palm does not teach or suggest the subject matter defined by independent Claim 28 or by dependent Claim 30. Accordingly, Claim 30 is allowable.

CONCLUSION

In view of the foregoing, reversal of the final rejection of Claims 2- 3, 5-14 and 23-30 and allowance of Claims 2-3, 5-14, and 23-30, in addition to previously-allowed Claims 13-14, are respectfully requested.

Respectfully submitted,



Edward R. Lawson Jr.
Reg. No. 41,931

Docket No. 66042-9223-01
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
(414) 271-6560

APPENDIX

2. The reciprocating saw as set forth in Claim 7 wherein the housing has an upper portion, a lower portion, and opposed side portions, and wherein the lever is operable from the lower portion of the housing.

3. The reciprocating saw as set forth in Claim 7 wherein the first grip surface is selectively engageable by one of the operator's first hand and the operator's second hand, and wherein the lever is operable by the one of the operator's first hand and the operator's second hand engaging the first grip surface.

5. The reciprocating saw as set forth in Claim 7 wherein the shoe support member defines therealong a plurality of teeth, wherein, in the locked position, the locking member engages the teeth so that the shoe support member is locked in a position relative to the housing, and wherein, in the unlocked position, the locking member does not engage the teeth and the shoe support member is movable relative to the housing.

6. The reciprocating saw as set forth in Claim 7 wherein the locking member is pivotable between the locked position and the unlocked position.

7. A reciprocating saw comprising:
a housing including a first grip surface for an operator's first hand and a second grip surface for an operator's second hand;
a motor supported by the housing;
a spindle movably supported by the housing, the spindle having an end adapted to support a saw blade;
a drive mechanism connected between the motor and the spindle to reciprocally drive the spindle relative to the housing upon operation of the motor;
a shoe for engaging a surface of a workpiece;
a shoe support member supporting the shoe, the shoe support member being movably supported by the housing;
a locking assembly operable to lock the shoe support member in a position relative to the housing; and
a lever for operating the locking assembly between a locked condition, in which the shoe support member is locked in a position relative to the housing, and an unlocked condition, in which the shoe support member is movable relative to the housing, the lever being supported on the first grip surface such that, during operation of said saw, the operator's first hand engages the first grip surface and the lever and thereby maintains the lever in a locked position corresponding to the locked condition of the locking assembly;
wherein the locking assembly includes a locking member engageable with the shoe support member, and wherein the lever is operable to move the locking member between a locked position, in which the locking member engages the shoe support member to lock the shoe support member in a position relative to the housing, and an unlocked position, in which the shoe support member is moveable relative to the housing;
wherein the locking member has a first end and a second end, and wherein the lever engages the first end and the second end of the locking member.

8. The reciprocating saw as set forth in Claim 7 wherein the lever includes a first lever member formed of a moldable material and a second lever member formed of a metallic material, the second lever member being molded with the first lever member, the second lever member defining a recess, one of the first end and the second end of the locking member engaging the recess.

9. The reciprocating saw as set forth in Claim 8 wherein the second lever member defines a first recess and a second recess, the first end and the second end of the locking member respectively engaging the first recess and the second recess.

10. A reciprocating saw comprising:
a housing including a first grip surface for an operator's first hand and a second grip surface for an operator's second hand;
a motor supported by the housing;
a spindle movably supported by the housing, the spindle having an end adapted to support a saw blade;
a drive mechanism connected between the motor and the spindle to reciprocally drive the spindle relative to the housing upon operation of the motor;
a shoe for engaging a surface of a workpiece;
a shoe support member supporting the shoe, the shoe support member being movably supported by the housing;
a locking assembly operable to lock the shoe support member in a position relative to the housing;
a lever for operating the locking assembly between a locked condition, in which the shoe support member is locked in a position relative to the housing, and an unlocked condition, in which the shoe support member is movable relative to the housing, the lever being supported on the first grip surface such that, during operation of said saw, the operator's first hand engages the first grip surface and the lever and thereby maintains the lever in a locked position corresponding to the locked condition of the locking assembly; and
a retainer member supported by the housing and defining a channel, and wherein the shoe support member is movable in the channel.

11. The reciprocating saw as set forth in Claim 10 wherein the shoe support member has a bottom wall and at least one side wall extending from the bottom wall, and wherein the retainer member supports the shoe support member along the bottom wall and along the side wall.

12. The reciprocating saw as set forth in Claim 11 wherein the shoe support member has an upper surface, and wherein a portion of the retainer member engages the upper surface.

13. A reciprocating saw comprising:

- a housing including a first grip surface for an operator's first hand and a second grip surface for an operator's second hand;
- a motor supported by the housing;
- a spindle movably supported by the housing, the spindle having an end adapted to support a saw blade;
- a drive mechanism connected between the motor and the spindle to reciprocally drive the spindle relative to the housing upon operation of the motor;
- a shoe for engaging a surface of a workpiece;
- a shoe support member supporting the shoe, the shoe support member being movably supported by the housing;
- a locking assembly operable to lock the shoe support member in a position relative to the housing;
- a lever for operating the locking assembly between a locked condition, in which the shoe support member is locked in a position relative to the housing, and an unlocked condition, in which the shoe support member is movable relative to the housing, the lever being supported on the first grip surface such that, during operation of said saw, the operator's first hand engages the first grip surface and the lever and thereby maintains the lever in a locked position corresponding to the locked condition of the locking assembly; and
- a retainer member supported by the housing and defining a channel, wherein the shoe support member is movable in the channel; and

wherein the housing defines a slot, the retainer member being supported in the slot.

14. A reciprocating saw comprising:

- a housing including a first grip surface for an operator's first hand and a second grip surface for an operator's second hand;
- a motor supported by the housing;
- a spindle movably supported by the housing, the spindle having an end adapted to support a saw blade;
- a drive mechanism connected between the motor and the spindle to reciprocally drive the spindle relative to the housing upon operation of the motor;
- a shoe for engaging a surface of a workpiece;
- a shoe support member supporting the shoe, the shoe support member being movably supported by the housing;
- a locking assembly operable to lock the shoe support member in a position relative to the housing;
- a lever for operating the locking assembly between a locked condition, in which the shoe support member is locked in a position relative to the housing, and an unlocked condition, in which the shoe support member is movable relative to the housing, the lever being supported on the first grip surface such that, during operation of said saw, the operator's first hand engages the first grip surface and the lever and thereby maintains the lever in a locked position corresponding to the locked condition of the locking assembly; and
- a retainer member supported by the housing and defining a channel, and wherein the shoe support member is movable in the channel;

wherein the locking assembly includes a locking member engageable with the shoe support member to lock the shoe support member in a position relative to the housing, the locking member including a first end and a second end, and wherein the retainer member defines a first opening and a second opening respectively receiving the first end and the second end of the locking member.

23. A reciprocating saw comprising:
a housing;
a motor supported by the housing;
a spindle movably supported by the housing, the spindle having an end adapted to support a saw blade;
a drive mechanism connected between the motor and the spindle to reciprocally drive the spindle relative to the housing upon operation of the motor;
a shoe for engaging a surface of a workpiece;
a shoe support member supporting the shoe, the shoe support member being movably supported by the housing;
a locking assembly operable to lock the shoe support member in a position relative to the housing, the locking assembly including a locking member engageable with the shoe support member, the locking member having a first end and a second end; and
a lever operable to move the locking member between a locked position, in which the locking member engages the shoe support member to lock the shoe support member in a position relative to the housing, and an unlocked condition, in which the shoe support member is movable relative to the housing, the lever engaging the first end and the second end of the locking member.

24. The reciprocating saw as set forth in Claim 23 wherein the locking member is pivotable between the locked position and the unlocked position.

25. The reciprocating saw as set forth in Claim 23 wherein the lever includes a first lever member formed of a moldable material and a second lever member formed of a metallic material, the second lever member being molded with the first lever member, the second lever member defining a recess, one of the first end and the second end of the locking member engaging the recess.

26. The reciprocating saw as set forth in Claim 25 wherein the second lever member defines a first recess and a second recess, the first end and the second end of the locking member respectively engaging the first recess and the second recess.

27. The reciprocating saw as set forth in Claim 23 and further comprising a retainer member supported by the housing and defining a channel, the shoe support member being movable in the channel, wherein the retainer member defines a first opening and a second opening respectively receiving the first end and the second end of the locking member.

28. A reciprocating saw comprising:
a housing;
a motor supported by the housing;
a spindle movably supported by the housing, the spindle having an end adapted to support a saw blade;
a drive mechanism connected between the motor and the spindle to reciprocally drive the spindle relative to the housing upon operation of the motor;
a shoe for engaging a surface of a workpiece;
a shoe support member supporting the shoe, the shoe support member being movably supported by the housing;
a locking assembly operable to lock the shoe support member in a position relative to the housing, the locking assembly including a locking member engageable with the shoe support member, the locking member having a first end and a second end; and
a lever operable to move the locking member between a locked position, in which the locking member engages the shoe support member to lock the shoe support member in a position relative to the housing, and an unlocked condition, in which the shoe support member is movable relative to the housing, the lever including a first lever member formed of a moldable material and a second lever member formed of a metallic material, the second lever member being molded with the first lever member, the second lever member defining a recess, one of the first end and the second end of the locking member engaging the recess.

29. The reciprocating saw as set forth in Claim 28 wherein the second lever member defines a first recess and a second recess, the first end and the second end of the locking member respectively engaging the first recess and the second recess.

30. The reciprocating saw as set forth in Claim 28 and further comprising a retainer member supported by the housing and defining a channel, the shoe support member being movable in the channel, wherein the retainer member defines a first opening and a second opening respectively receiving the first end and the second end of the locking member.